REMARKS

Applicant has carefully studied the Office Action of July 23, 2004, and offers the following remarks in response thereto.

Applicant herein amends claims 1, 2, 6, 7, 9, 12, 14, and 17 to fix typographical errors and to clarify antecedent basis of the various claim terms. No new matter is added and the scopes of the claims have not changed.

The Patent Office indicates that the objection to the drawings will not be held in abeyance. Figure 1, by virtue of the amended drawings filed May 15, 2003, has box 10 presented with the label "switch". Applicant did not request the objection to the drawings be held in abeyance, but rather requested in Applicant's previous response, that the objection to the drawings be withdrawn since Applicant had complied with the request of the Patent Office to include the term "switch" in box 10 of Figure 1. As such a corrected drawing has been submitted and approved. New formal drawings are not required until allowance. 37 C.F.R. §§ 1.84; 1.85; 1.121; MPEP § 608.02(a); 608.02(b).

Before addressing the merits of the rejections based on the references, Applicant provides a brief summary of the invention so that the remarks are considered in the proper context. The present invention is directed to a system and method for requesting operations and management data from a telephony switch. Operations and management data are defined in paragraph 0002 to be "collection and exchange of data relating to telephony trunks; traffic measurement and management; configuration of telephony switches; fault analyses; performance measurement and management; and overall network management." To secure this operations and management data, the current invention creates a network over a packet switched data network distinct from the Public Switch Telephone Network (PSTN), and sends a specific type of packet over the packet switched data network. That specific type of packet comprises a network address to identify the switch, and a second network to identify the computing device. Furthermore, the packet has a first message type identifier that identifies a message at least partially within the packet as a data request message, and a second message type identifier identifying a type of operations and management data requested from the telephony switch. The packet is then forwarded to the telephony switch, and the telephony switch provides the requested data to the computing device. Different types of operations and management data may be requested from different ports on the telephony switch.

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Claims 1, 4-8, and 15-17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Erb et al. (hereinafter "Erb"). Applicant respectfully traverses. For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. The requirement that each and every element be disclosed in the manner claimed is a rigorous standard that the Patent Office has not met in this case.

Applicant previously argued that the elements within Erb identified by the Patent Office as corresponding to the claim language did not match the claim language. Specifically, Applicant argued that the two message type identifiers were not present in Erb. The Patent Office responds by changing its interpretation of the reference. The Patent Office now asserts that the first message type identifier is inherent and the second message type identifier is found at Erb, col. 13, lines 7-10, 20-21; col. 6, lines 54-60; and col. 36, lines 13-20. Applicant traverses the inherency of the first message type identifier.

For the Patent Office to assert that an element is inherent in a reference, the element must necessarily be present in the reference. MPEP § 2112. The burden of proof is on the Patent Office. *Id.* It is insufficient for the Patent Office to argue that an element may be present in a reference. While the Patent Office has argued that the first message type identifier that identifies the message as a data request message is inherent, the Patent Office's analysis on this point is insufficient to establish the inherency of the element, especially in the context of the strict requirements of an anticipation analysis. Specifically, the Patent Office's analysis is: "Figure 3A, step 134a and Figure 3B, step 135; note: a packet containing a read command is identified and is distinguished from a packet containing a wire command -- Figure 3C, step 141a and Figure 3D, step 142 . . . ." There is no requirement in Erb that the read command be associated with a message type identifier. There are many protocols that do not require message type identifiers to identify the message as a data request message.

In light of the fact that Erb does not inherently need to have a message type identifier, Erb cannot anticipate claim 1. Since Erb does not anticipate claim 1, the rejection of claim 1 is improper, and Applicant requests withdrawal of the § 102 rejection of claims 1 and 4-6 at this time.

Claim 7 recites a similar sort of first message type identifier except that it identifies the packet as at least partially containing a message formed in response to the request. While Erb

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does teach responding to requests to "Get Tuples", there is no teaching or suggestion in the art that such a response necessarily has a message type identifier that identifies the packet as a response to a request.

Since Erb does not inherently teach the first message type identifier of claim 7, Erb cannot anticipate claim 7. Since Erb does not anticipate claim 7, the rejection of claim 7 is improper, and Applicant requests withdrawal of the § 102 rejection of claim 7 at this time.

Claims 15 and 16 are, in relevant part, substantially the same as claim 1, and are not anticipated at least for the same reason. Specifically, claims 15 and 16 recite "a first message type identifier, identifying said packet as at least partially containing a data request message," which, as explained above, is not necessarily present in Erb. Applicant requests withdrawal of the § 102 rejection of claims 15 and 16 at this time.

Claim 17 is, in relevant part, substantially the same as claim 7, and is not anticipated at least for the same reason. Specifically, claim 16 recites "a first message type identifier, identifying said packet as at least partially containing a message formed in response to the request," which, as explained above, is not necessarily present in Erb. Applicant requests withdrawal of the § 102 rejection of claim 17 at this time.

Claims 2-3 and 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Erb in view of Rutkowski et al. (hereinafter "Rutkowski"). Applicant respectfully traverses. Applicant previously argued that to combine references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the motivation to combine the references with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

The Patent Office responds to this standard with an outdated analysis. The Federal Circuit has increased the level of proof required by the Patent Office. Specifically, *Dembiczak* states:

> [w]e have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved . . . The range of sources available, however, **does not diminish the requirement for <u>actual evidence</u>. That is, the showing must be clear and particular.**

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Id. (emphasis added and internal citations omitted). Thus, while the Patent Office has articulated the motivation, the Patent Office has not provided the actual evidence mandated by the Federal Circuit. That is, the motivation in the "Response to Arguments" section, namely, "to prevent unauthorized access to the information stored on the device which is well known in the art, such as requiring a login ID and password for access to a web page . . ." has not been supported with any sort of evidence. The broad assertion that it is well known in the art is insufficient. The Patent Office has to provide **actual evidence**, which, to date, the Patent Office has not done.

The Patent Office relies on a slightly different motivation on page 5 of the Office Action, stating: "to authenticate a user requesting access to a system resource . . ." This motivation is devoid of any actual evidence, and is likewise insufficient to support the combination of references.

Since the Patent Office has not complied with the mandate from the Federal Circuit, the combination remains improper, and the references must be considered individually. As previously explained, the references individually do not establish obviousness, and the claims are allowable. Applicant requests the withdrawal of the § 103 rejection of claims 2, 3, 9, and 10 at this time on this basis.

Even if the combination is proper, a point which Applicant does not concede, the combination does not show all the claim elements. Specifically, as discussed above, Erb lacks the first message type identifier. Nothing in Rutkowski cures the deficiencies of Erb. Thus, in combination, Erb and Rutkowski still do not teach the first message type identifier, and do not establish obviousness. Applicant requests withdrawal of the § 103 rejection of claims 2, 3, 9, and 10 at this time on this basis.

Claims 11-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Acharya et al. (hereinafter "Acharya") in view of Byers. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection because the Patent Office has not substantiated the motivation to combine the references. Specifically, the Patent Office opines that the motivation to combine Acharya and Byers is "to have the switch in the invention of Acharya provide the telephony services in order to provide additional fee-based services to customers." This motivation is not properly supported with actual evidence as required. Since the motivation

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is not properly supported, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the references must be considered individually. The Patent Office admits that Acharya does not teach all the elements. As previously explained, Byers does not teach all the elements either and thus, the references individually do not teach or suggest all the claim elements. Since the references individually do not teach or suggest all the claim elements, the references individually do not establish obviousness, and the claims are allowable.

Applicant further traverses the assertions made by the Patent Office regarding the content of Acharya. Specifically, the Patent Office asserts that Acharya exchanges operations and management data over two network connections, pointing to Acharya, col. 8, lines 29-35 and 37-39. While the cited passage does mention that operations, administration and maintenance ("OAM") cells are sent (col. 8, lines 33-35), such OAM cells are sent on a single virtual path/virtual channel ("VP/VC"). There is no indication that OAM cells are sent on two network connections. In fact, the cited passage suggests that the OAM VP/VC is distinct from the normal flows, and only occasionally will a message associated with the flow be sent on the same VP/VC. Nothing in Byers cures the deficiencies of Acharya. Thus, in combination, the references do not teach or suggest a claim element and cannot establish obviousness.

The Patent Office's further assertion that Acharya shows different priorities does not show different connections being used for operations and management data of differing priorities as claimed. That is, the Patent Office asserts that Acharya, col. 19, lines 26-29 teaches the packets of the first and second network connections associated with first and second priorities. While the passage does indicate that particular service classes are sent without guarantees, the passage does not indicate that the services classes are sent over different network connections based on the differing services classes or the presence or absence of a guarantee. Thus, the reference does not show the element for which it is cited. Nothing in Byers cures the deficiencies of Acharya. Thus, in combination, the references do not teach or suggest this element and cannot establish obviousness.

Since the combination of references does not establish obviousness, Applicant requests withdrawal of the § 103 rejection of claims 11-14 at this time. Applicant further requests withdrawal of the § 103 rejection of claim 13 as unpatentable over Acharya and Byers because in the next section of the Office Action, the Patent Office admits that the combination of Acharya

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and Byers does not disclose that the ATM connections are based on logical ports (see Office Action page 6, lines 13-14).

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Acharya in view of Byers, and in further view of Mori. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection because the rejection is based on the combination of Acharya and Byers. As explained above, the Patent Office has not substantiated the motivation to combine Acharya and Byers and thus, this underlying combination remains improper. Since the underlying combination is improper, the combination of the three references is improper. Applicant requests withdrawal of the § 103 rejection of claim 13 on this basis.

Applicant further traverses the rejection because, as explained above, Acharya and Byers do not teach the elements for which they are cited relative to independent claim 11. Nothing in Mori cures this deficiency. Thus, in combination, the three references cannot establish obviousness. Since the three references cannot establish obviousness, the rejection is improper. Applicant requests withdrawal of the § 103 rejection of claim 13 on this basis.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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